

REMARKS

Applicant has carefully reviewed the Office Action of 03 October 2002 and offers the following remarks.

The Patent Office has issued several rejections under 35 U.S.C. § 112 which are unfounded. In particular, the Patent Office has rejected the claims due to the use of numerous terms which the Patent Office alleges are not clearly defined. Applicant generally traverses this position. The Patent Office is required to give a claim term the broadest reasonable interpretation that someone of ordinary skill in the art would apply. If the term is not a term of art, the Patent Office is entitled to use a dictionary to supply a meaning. Adhering to this standard, the terms have well defined meanings.

Claims 1-4, 6-9, 13-16, 18-21, 25, and 27 were rejected under 35 U.S.C. § 112 as being indefinite. Specifically, the Patent Office opined that the term "characteristic" is not clearly defined. Applicant respectfully traverses. As discussed in the telephonic interview of 26 November 2002, Applicant defines the term "characteristic" by example in numerous places in the specification, including, but not limited to: paragraph 10, Figure 2, and Figure 4. As Primary Examiner Hoosain indicated in the interview, definitions by example remove the term from the realm of indefiniteness, and thus, the § 112 rejection for this term is unfounded. Applicant requests withdrawal of this § 112 rejection at this time.

Claims 2, 3, 5, 14, 15, and 17 were rejected under 35 U.S.C. § 112 as being indefinite. Specifically, the Patent Office opined that the term "a portion" is not clearly defined. Merriam Webster's online dictionary defines a "portion" as "an often limited part set off or abstracted from a whole." Applicant concurs that this is an appropriate definition. In the context of the present invention, one of ordinary skill in the art would know that "a portion" means a limited part set off from the whole. For example, in claim 2, the relevant sections of the claim read "at least a limited part of the instant message." One of ordinary skill in the art would have no trouble coming to this definition, and the claim is definite on face. Applicant requests withdrawal of the § 112 rejection of claims 2, 3, 5, 14, 15, and 17 at this time.

Claims 3 and 15 were rejected under 35 U.S.C. § 112 as being indefinite. Specifically, the Patent Office opined that the term "possible" is not clearly defined. Merriam Webster's online dictionary defines "possible" as "being within the limits of ability, capacity, or realization." Applicant concurs that this is an appropriate definition. In the context of the

present invention, one of ordinary skill in the art would know that "possible" means being within the limits of ability. For example, in claim 3, the relevant section of the claim reads "within a chosen one of the plurality of message characteristics that are within the limits of ability." One of ordinary skill in the art would have no trouble coming to this definition, and the claim is definite on face. Applicant requests a withdrawal of this rejection of claims 3 and 15 at this time.

Claims 3 and 15 were additionally rejected because the Patent Office opined that "unique" is not clearly defined. Merriam Webster's online dictionary defines "unique" as "being without a like or equal." Applicant concurs that this is an appropriate definition. In the context of the present invention, one of ordinary skill in the art would know that "unique" means being without a like or equal. For example, in claim 3, the relevant section of the claim reads "with a chosen one of the plurality of text that has no identical text." One of ordinary skill in the art would have no trouble coming to this definition, and the claim is definite on face. Applicant requests withdrawal of this rejection of claims 3 and 15 at this time.

Claims 5 and 17 were rejected under 35 U.S.C. § 112 as being indefinite. Specifically, the Patent Office opined that the term "color" is not clearly defined. Merriam Webster's online dictionary defines "color" as "a hue as contrasted with black, white, or gray." Applicant concurs that this is an appropriate definition. In the context of the present invention, one of ordinary skill in the art would know that "color" means being a hue as contrasted with black, white, or gray. For example, in claim 5, the relevant section of the claim reads "and a hue as contrasted with black, white, or gray imparted in at least a portion of the text." One of ordinary skill in the art would have no trouble coming to this definition, and the claim is definite on face. Applicant requests withdrawal of this rejection of claims 5 and 17 at this time.

Claims 1, 7, 10, 13-16, 18-22, and 25-27 were rejected under 35 U.S.C. § 112 as being indefinite. Specifically, the Patent Office opined that the term "instant" is not clearly defined. The term, however, may not be considered in isolation. The term "instant" modifies "message" and thus becomes the term of art "instant message." An instant message is a message sent by an instant messaging service such as AOL's instant messenger, Yahoo! Messenger service, IRC, IRQ, and the like. Someone of ordinary skill in the telecommunications industry knows what an instant message is and knows what sorts of programs deliver this service. AOL's instant messenger has been around since at least 1999, well before the filing date of the present

application. There is no indefiniteness created by the use of this term, and Applicant requests withdrawal of this § 112 rejection at this time.

Claims 10, 13, 22, and 26 were rejected under 35 U.S.C. § 112 as being indefinite. Specifically, the Patent Office opined that the phrase "instant messaging service" is not clearly defined. As explained above, instant messaging services are extremely well known in the telecommunications industry. No one of ordinary skill in the art would consider this term indefinite. Applicant requests withdrawal of the rejection of these claims at this time.

Claims 7 and 19 were rejected under 35 U.S.C. § 112 as being indefinite. Specifically, the Patent Office opined that the term "relative" is not clearly defined. Dictionary.com's online dictionary defines the term "relative" to mean "considered in comparison with something else." Applicant concurs that this is an appropriate definition. In the context of the present invention, one of ordinary skill in the art would know that "relative" means being considered in comparison with something else. For example, in claim 7, the relevant section of the claim reads "relates to a volume considered in comparison with a total possible volume." One of ordinary skill in the art would have no trouble coming to this definition, and the claim is definite on face. Applicant requests withdrawal of this rejection of claims 7 and 19 at this time.

The Patent Office further commented that claim 23 recites the limitation "the content" and that there was insufficient antecedent basis for the element. Applicant herein amends claim 23 to provide the appropriate antecedent basis.

Applicant now turns to the rejections based on the references. Claims 1, 2, 6, 8, 14, 18, 20, and 25-27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Griffith et al. For a proper anticipation rejection, the Patent Office must show where each and every claim element is located and how it is arranged identically to the structure or method claimed. MPEP § 2131. The Patent Office has failed to show how the Griffith et al. reference anticipates the claim for at least two reasons. The first reason is that the reference does not show an instant messaging activity as recited in the claims. The second reason is that the content of the message is not based on the message characteristic.

With respect to the first reason, the Griffith et al. reference is directed to converting between text and voice. However, the contemplated textual formats of communication are e-mail and facsimile transmissions. Applicant has carefully reviewed the reference and finds no mention of any sort of instant messaging service. Applicant believes that in light of the fact that

the Patent Office felt that the term "instant" was indefinite, perhaps the Patent Office did not give this claim limitation the appropriate weight when evaluating the reference. Given the comments above which clarify the nature of the instant message and the instant messaging service, the indefiniteness issue has been addressed and the claim element is not shown by the reference. Since the claim element is not shown, the claim is not anticipated.

With respect to the second reason, applicant appreciates the telephonic interview with the Examiner and Primary Examiner Hoosain when the Examiner clarified that the characteristic of the claim was being equated with the term "format" in column 5, lines 19-21, 31-35 of the reference. Applicant herein amends claim 1 to clarify that it is not just the instant message that is based on the message meaning and the message characteristic, but that it is the content of the instant message that is based on the message meaning and characteristic. The content is the actual information conveyed to the user and not the electronic mechanism or protocol used to deliver such content. In contrast, Griffith et al. explicitly states that the format relates to the type of message that is sent rather than the content of the message. Certainly Griffith et al. does not change the content of the message based on the format, but rather changes the type of message from email to voice mail or the like based on the format indicated.

Thus, at least two recited claim elements are not shown by the reference, and the claim is not anticipated. Applicant requests withdrawal of the § 102 rejection of claim 1 at this time.

Claim 2 depends from claim 1 and is allowable at least for the reasons that claim 1 is allowable.

Claim 6 depends from claim 1 and is allowable at least for the reasons that claim 1 is allowable. Further, claim 6 further defines the term "characteristic." Claim 6 recites that the characteristic relates to personality. The Patent Office asserts that it is inherent that the message characteristic must relate to personality if the message sender of Griffith et al.'s system desires to describe personality in the message. For an attribute to be inherent in a reference, the attribute must necessarily be present in the reference. MPEP § 2112. To the extent that the characteristic was identified as the format by the Examiner during the interview of 26 November 2002, it is impossible for the format which identifies a message type to identify a personality. To that extent, it is impossible for this format to contain necessarily a personality. Still further, if the Patent Office changes its position about what a characteristic is, there is not a reason that

necessarily forces any of the users of Griffith et al.'s device to describe personality in the message. Thus, claim 6 is independently not anticipated by the reference.

Claim 8 depends from claim 1 and is patentable for at least the reasons that claim 1 is patentable. Further, claim 8 recites a listing of what the characteristics might be. In the interview of 26 November 2002, Primary Examiner Hoosain indicated that such a listing would define over the reference. This is especially true in light of Examiner's later comment that the characteristic is the format of column 6. There is no teaching or suggestion that the format of column 6 has any relation to the volume, personality, or emotion as recited in claim 8. Griffith et al. does not change the content of the textual message based on volume, personality or emotion. Thus, Griffith et al. cannot, contrary to the Patent Office's assertion, "have the characteristics of volume, personality and emotion available for associating with the message." Thus, claim 8 is independently patentable over the reference.

Claims 14, 18, and 20 depend from claim 13, which was not rejected under an anticipation theory. Because claims 14, 18, and 20 have all of the limitations of claim 13, and claim 13 is not anticipated, claims 14, 18, and 20 cannot be anticipated. Applicant requests withdrawal of the § 102 rejection of claims 14, 18, and 20 in light thereof. If the Patent Office intended to reject claim 13 under 35 U.S.C. § 102(e) in view of Griffith et al., then the arguments relating to claim 1 are equally applicable – namely, the reference does not show the instant messaging activity and the reference does not show creating an instant message having content based on the message meaning and the message characteristic. Likewise, the arguments presented above with respect to claims 6 and 8 also apply to the rejections of claims 18 and 20.

Applicant cancels claims 26 and 27 thereby mooting the rejection thereof.

Claims 3 and 15 were rejected under 35 U.S.C. § 103 as being unpatentable over Griffith et al. in view of Burkey et al. Applicant respectfully traverses this rejection. In the Office Action, the Patent Office identified the characteristics as Burkey et al.'s placeholder. This is contrary to the position made in the interview of 26 November 2002 that the format of Griffith et al. is the characteristic. The Patent Office is, in effect, making a shifting rejection that is impermissible under the relevant standards of the MPEP. Specifically, the Patent Office must take a consistent approach to the claim language. Applicant further traverses this rejection on the grounds that Burkey et al. is non-analogous art. There is no text-voice conversion and no communication to a second party. Still further, there is no instant messaging. In short, the

reference has nothing to commend itself to an inventor faced with the problem solved by the present invention. Still further, the motivation to combine the references is suspect. The Patent Office asserts that it would have been obvious to modify Griffith et al. with the teachings of Burkey et al., but then offers no reason. The Patent Office is obligated to make specific findings about why two references should be combined. Here, where the relevance and analogousness of Burkey et al. are in question, the motivation must be more compelling.

If the non-analogousness and lack of motivation were not sufficient to find claims 3 and 15 patentable over the combination, the Patent Office has further failed to make a *prima facie* case of obviousness with the combination. The MPEP § 2143.03 indicates that to make a *prima facie* case of obviousness, the Patent Office must show where each and every element of the claim is located in the combination. Here, as explained above, Griffith et al. does not teach the instant messaging or the content of the message being based on the characteristic. Nothing in Burkey et al. cures this because Burkey et al. is not concerned with and does not address instant messaging. Nothing in Burkey et al.'s putative characteristic (or "placeholder") changes the content of the message. Thus, neither reference individually teaches or suggests the two claim elements. Since neither reference individually teaches the claim elements, the two references in combination cannot teach the claim element, absent a motivation to change the combination to include the claim element. Since the Patent Office has not advanced a reason to modify the combination to include instant messaging or base the content of the message on the characteristic, the combination does not make a *prima facie* case of obviousness and the claims are allowable over the rejection of record.

Claims 4 and 16 were rejected as being unpatentable over Griffith et al. in view of Dowens et al. The Patent Office, in constructing its rejection of these claims, relies on the concept of inherency. Applicant reminds the Patent Office of the standard of inherency expressed in MPEP § 2112, which states that for something to be inherent it must necessarily be present. The Patent Office indicates that if an emotional message is sent, then inherently the instant message derived therefrom is based on that emotion. This ignores the Patent Office's interpretation that the characteristic corresponds to the format of the message. Nothing about the format changes the content of the message in any manner based on emotion. Further, as noted above, the Patent Office must show where in the combination each and every element of the claim is located to make a *prima facie* case of obviousness. In the instant case, as pointed out

above, Griffith et al. does not teach the instant messaging nor the content based on the characteristic (because the Patent Office has defined "characteristic" to be the format). Nothing in Dowens et al. cures this deficiency. Thus, since neither reference individually shows the claim elements, the references in combination cannot show the claim elements. Since the claim elements are not shown, the Patent Office has failed to make a *prima facie* case of obviousness, and claims 4 and 16 are allowable over the rejection of record.

Claims 5 and 17 were rejected under 35 U.S.C. § 103 as being unpatentable over Griffith et al. and Dowens et al. in view of Rivera et al. The Patent Office indicates that it would have been obvious to modify the combination of Griffith et al. and Dowens et al. to use the emoticons of Rivera et al. This still does not address the underlying deficiencies of the underlying reference. Nothing in Rivera et al. provides the missing instant messaging or basing the content of the message on the characteristic. Since these elements are not shown by the references individually, the combination of references cannot show these elements, and the Patent Office has failed to make a *prima facie* case of obviousness.

Claims 7 and 19 were rejected under 35 U.S.C. § 103 as being unpatentable over Griffith et al. in view of Lynn. The Patent Office fails to make a *prima facie* case of obviousness because the instant message and the message having content as determined by the characteristic are not shown by the combination of references. As discussed above, Griffith et al. does not disclose these two elements. Nothing in Lynn corrects this deficiency. Since these elements are not shown by the references individually, the combination of references cannot show these elements, and the Patent Office has failed to make a *prima facie* case of obviousness.

Claims 9 and 21 were rejected under 35 U.S.C. § 103 as being unpatentable over Griffith et al. in view of Rivera et al. The Patent Office fails to make a *prima facie* case of obviousness because the instant message and the message having content as determined by the characteristic are not shown by the combination of references. As discussed above, Griffith et al. does not disclose these two elements. Nothing in Rivera et al. corrects this deficiency. Since these elements are not shown by the references individually, the combination of references cannot show these elements, and the Patent Office has failed to make a *prima facie* case of obviousness.

Claims 10 and 22 were rejected under 35 U.S.C. § 103 as being unpatentable over Griffith et al. in view of Boys. The Patent Office fails to make a *prima facie* case of obviousness because the instant message and the message having content as determined by the characteristic

are not shown by the combination of references. As discussed above, Griffith et al. does not disclose these two elements. Nothing in Boys corrects this deficiency. Since these elements are not shown by the references individually, the combination of references cannot show these elements, and the Patent Office has failed to make a *prima facie* case of obviousness.

The Patent Office addresses claim 11 under this section heading without formally rejecting the claim. If the Patent Office intended to reject claim 11 over Griffith et al. in view of Boys, the above arguments are just as applicable there.

Claims 12 and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over Griffith et al. in view of Hodges et al. The Patent Office fails to make a *prima facie* case of obviousness because the instant message and the message having content as determined by the characteristic are not shown by the combination of references. As discussed above, Griffith et al. does not disclose these two elements. Nothing in Hodges et al. corrects this deficiency. Since these elements are not shown by the references individually, the combination of references cannot show these elements, and the Patent Office has failed to make a *prima facie* case of obviousness.

Claim 23 was rejected under 35 U.S.C. § 103 as being unpatentable over Griffith et al. in view of Boys. The Patent Office fails to make a *prima facie* case of obviousness because the instant message and the message having content as determined by the characteristic are not shown by the combination of references. As discussed above, Griffith et al. does not disclose these two elements. Nothing in Boys corrects this deficiency. Since these elements are not shown by the references individually, the combination of references cannot show these elements, and the Patent Office has failed to make a *prima facie* case of obviousness.

Applicant requests reconsideration of the rejection in light of the explanations provided herein and application of the proper use of the terms "characteristic" and "instant messaging." Applicant requests withdrawal of the rejections in light of the arguments presented herein and claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE**In the claims:**

Please cancel claims 26 and 27 without prejudice.

Please amend claims 1, 13, 23, and 25 as follows:

1. (once amended) A method for facilitating instant messaging for a telephony user comprising:
 - a) receiving a command derived from an audio command provided by a telephony user, the command including a message meaning with a message characteristic;
 - b) creating an instant message having content based on the message meaning and message characteristic; and
 - c) sending the instant message to a second user via an instant messaging service.
13. (once amended) A system for facilitating instant messaging for a telephony user comprising:
 - a) a communication interface for communicating with an instant messaging service and a device capable of communicating with the telephony user; and
 - b) a control system associated with the communication interface and adapted to:
 - i) receive a command derived from an audio command provided by the telephony user, the command including a message meaning with a message characteristic;
 - ii) create an instant message having content based on the message meaning and the message characteristic; and
 - iii) send the instant message to a second user via the instant messaging service.
23. (once amended) The system of claim 13 further comprising an audio browser adapted to convert [the] content directed to the telephony user into an audible message and deliver the audible message to the telephony user via the audio browser.
25. (once amended) A computer readable medium with software facilitating instant messaging for a telephony user and comprising instructions for a computer to:
 - a) receive a command derived from an audio command provided by the telephony user, the command including a message meaning with a message characteristic;

b) create an instant message having content based on the message meaning and message characteristic; and

c) send the instant message to a second user via an instant messaging service.